REMARKS

This paper is responsive to an Office Action dated August 10, 2004. Prior to this amendment claims 1-45 were pending. After amending claims 1-2, 4-8, 10, 13-17, 19-20, 23-26, 30-32, 35-36, and 39-42, canceling claims 3, 12, 34, and 37-38, and adding claims 46- 54, Claims 1-2, 4-11, 13-33, 35-36, and 39-54 remain pending.

In Section 2 of the Office Action claims 1-45 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Wahi, in view of Kung et al. ("Kung"; US 6,252,952). With respect to claims 1 and 23, the Office Action states that Wahi discloses a lockout system, but acknowledges that Wahi does not disclose a gateway. The Office Action further states that Kung teaches the use of various gateway and endpoints that are connected to each other, and that it would have been obvious for one of ordinary skill at the time of the invention to combine Wahi's POTS lockout system, as "Kung et al. would merely provide a more modern environment upon which the teachings of Wahi would be implemented. Moreover, because Kung et al. teaches the ability to interconnect and control standard POTS telephones, nothing that Wahi et al. teaches would interfere with or teach away from anything that Kung et al. teaches." With respect to claim 3, the Office Action states that Wahi enables public and privacy modes of operation. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As

stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Wahi describes a POTS type system where the lines to the central office are connected to telephone extensions (see the upper left hand corner of Fig. 1). Wahi's invention involves the use of blocking circuitry that is enabled through the use of two additional electrical lines (y and b) that are connected to each extension (col. 3, ln. 28-40). When the y/b lines are enabled at one extension phone, all the other phones are blocked from the external telephone line.

Generally, Kung describes an Internet Protocol based network 120 that can be integrated to communicate with other network types such a POTS 160, ATM 185, and a residential gateway 300, among others (col. 3, ln. 21-33, see Fig. 1), using a collection of gateways associated with IP station 200 (see Fig. 2). Fig. 3 describes a residential gateway 300, which is connected to customer premise equipment (CPE) 102 such as televisions, computers, and telephones (col. 3, ln. 34-50). Fig. 3 supports an explanation of the residential gateway 300. Residential gateway 300 couples to general network 1 (of Fig. 1) through a transceiver 302. Kung describes an intercom module (IM) 344 associated with the

residential gateway that permits the CPE telephones to be used as intercoms, and a controller 306 that determines intercom paths (col. 18, ln. 56-67). The IM can also perform telephony services such as extension transfer, conferencing, and caller ID (col. 19, ln. 18-20). However, Kung provides no details as to how these functions are implemented.

The Office Action states that Kung provides a modern environment in which to implement Wahi's teachings, and that the teachings of the two references are not in contradiction with each other. However, these statements are not sufficient to support a *prima facie* case of obviousness. First, there are no details in the Kung reference to support the position that Kung's system can implement Wahi's lockout feature. More important however, even if the combination suggested a gateway-enabled lockout system, this system would not describe the claimed invention (as amended). Claims 1 and 23 have been amended to incorporate features previously described in claim 8.

Referencing claim 3, the Office Action states that Wahi teaches both private and public modes of operation, where the privacy mode can be selected by pushing a button on one of the telephones. Restated, in Wahi's system, privacy can be enabled for a phone, for a particular call. However, Wahi's system does enable the privacy mode to be selected for an external telephone line, as recited in claims 1 and 23. In fact, Wahi system couldn't even be enabled with multiple external lines. By independently selecting modes of operation for different external telephone lines (the claimed invention), it is the external line transceiving a call that determines mode selection, not a button on a telephone. This is a novel approach to configuring mode selection that is not taught in the prior art.

The support the Applicant's position, an affidavit has been prepared by Dr Srinivas Kandala, enclosed as Attachment A. In his affidavit Dr. Kandala states that even if motivation could be found to combine the prior art references, the combination does not suggest the limitations recited in the base claims. Dr. Kandala states that the ability to set privacy/public modes independently for the external telephone line stems from a unique gateway processing method. Unlike conventional access systems, the claimed invention gateway correlates a telephone number with an external telephone line, instead of with a particular telephone. This permits an endpoint to be configured differently for each external telephone line (telephone number). In turn, uncoupling the endpoint from a particular telephone number enables the claimed privacy/public mode functions.

With respect to the first *prima facie* requirement to support a case for obviousness, there appears to be no motivation to combine POTS and gateway telephone references. If the references are being combined to suggest that Kung can be modified to enable a lockout function, then it is probably true that almost any POTS phone function can be mimicked given enough experimentation. That is, while Wahi may suggest a lockout concept, Wahi' analog system provides no guidance as to how such a function could be implemented in a gateway phone system.

With respect to suggestion/motivation, the *Response to the Arguments* Section of the Office Action (page 9, last paragraph) states that "having established that this knowledge was in the art, the Examiner can rely ... on a conclusion of obviousness... from common knowledge and common sense of the person of ordinary skill in the art...", citing In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). The

Applicant requests that any limitations suggested by "common sense" be put on the record, to permit the Applicant the opportunity for rebuttal.

Neither does the Office Action's assertion that Kung provides a modern environment for Wahi's POTS lockout system point to the reasonable expectation of success in the present invention, which is the second *prima facie* requirement of the obviousness analysis. Even if Kung can be combined with Wahi, the combination does not show privacy/public mode options that can be independently selected for external telephone lines. Wahi's invention only has application to an analog POTS system, and Kung supplies no residential gateway details that support the kind of selective bridging recited in the Applicant's claims.

With respect to the third requirement to support a *prima facie* case of obviousness, the combination of references does not teach all the limitations of claims 1 and 23. Claims 1 and 23 recite the limitations of independently selecting privacy/public mode options for external telephone lines, and selectively excluding bridges between an external telephone lines and Home Network endpoints in response to the selection the privacy mode. Wahi shows no selective control over which extensions are disconnected. Kung describes only intercom, transfer, and conferencing telephony functions. With respect to claim 1 and 23, the combination of all these functions does not teach that privacy/public mode functions can be independently selected for external telephone lines. As mentioned above, these limitations are built upon a novel method of correlating external lines, endpoints, and telephone numbers. Without this novel correlation method, no combination of prior art references can make the claimed invention obvious. Therefore, the combination of references neither explicitly describes all the limitations of claims 1 and

23, nor suggests modifications that make these claims obvious. Claims 2, 4-11, 13-22, and 46-48, dependent from claim 1, and claims 24-33, 35-36, 39-45, and 49-54, dependent from claim 23, enjoy the same benefits and the Applicant respectfully requests that the rejections be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

Date: 10/22/04

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